

REMARKS

I. Status of Claims

Claims 1, 3, 18, 25, 28, 38, 39, and 43-58 are currently pending. New claims 70 and 71 have been added. Support for new claims 70 and 71 can be found in the originally-filed specification and claims, including, for example, original claims 40 and 41. No new matter has been added.

Although Applicants recognize that the subject matter of new claims 70 and 71 has been withdrawn as directed towards a non-elected species, Applicants believe that the subject matter of independent, generic claim 57 is allowable, and thus the Examiner is obligated to rejoin the withdrawn subject matter directed towards the species.

M.P.E.P. § 821.04(a).

II. Provisional Obviousness-Type Double Patenting Rejection

Claims 1, 3, 18, 25, 28, 38, 39, and 43-58 have been provisionally rejected for obviousness-type double patenting over claims 1, 12, 16, 20, and 21 of U.S. Application Serial No. 09/759,530 ("the '530 application"). According to the Office, the '530 application "particularly claims the elected amphoteric starch, and at least one cationic polymer." Office Action at 2. Applicants respectfully request the Office hold the provisional rejection in abeyance until allowable subject matter is indicated.

III. Rejections under 35 U.S.C. § 103

A. Sweger in view of Matsumoto and Uchiyama

Claims 1-3, 18, 25, 28, 38, 39, and 43-58 have been rejected under 35 U.S.C. § 103 as allegedly obvious over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ("Matsumoto") and U.S. Patent No. 5,876,705 to Uchiyama et al. ("Uchiyama"). Although the Office admits that "Sweger does not teach expressly [certain] ingredients in the hair composition, such as [the] conditioning agent behenyltrimethylammonium, or [the] anionic surfactant alkyl ether sulfate," the Office attempts to rectify that deficiency with Matsumoto and Uchiyama as teaching "well known essential ingredients normally used for hair compositions." Office Action at 3. Applicants respectfully disagree and traverse this rejection.

To establish a *prima facie* case of obviousness, the Office must establish, among other things, that there is some suggestion or motivation to combine the reference teachings with a reasonable expectation of success. M.P.E.P. § 2143. The Office, however, has failed to meet this burden for at least the reason that there is no suggestion or motivation to combine Sweger with either Matsumoto or Uchiyama.

Applicants have established this lack of motivation in great detail on the record, not only by citation to the references themselves, but also through a Declaration under Rule 1.132 of MME. MAHE filed on September 13, 2005, demonstrating unexpected results obtained by the claimed composition. The Examiner agreed that this Declaration, as well as Applicants' detailed discussion of the references "are persuasive to claimed subject matter wherein the amphoteric starch is those of formula (I) The

subject matter is allowable because of the unexpected benefit shown in the declaration.”

November 30, 2005, Office Action at 5.

In an effort to expedite prosecution, Applicants amended the claims to recite formula (I), and after the present Examiner allowed the case, Applicants paid the issue fee on July 26, 2006. The Examiner has now, however, withdrawn the application from issue, alleging in the present Office Action that “the claimed invention is not commensurate in scope with the data presented in the declaration,” as “the claimed invention is not limited to hair care product, and read[s] on a variety of cationic agents beyond the three tested agents. Further, the claimed compositions [are] open to further comprising any other known cosmetics.” Office Action at 6.

The Office’s analysis of Mme. MAHE’s Declaration, and its subsequent rejection of the claims, severely misinterprets not only the declaration itself, but also general principles of examination in the realm of unobviousness. Applicants agree with the Office that the present claims are not limited to hair care compositions, such as those tested by Mme. MAHE. Moreover, the claims are open not only to the cationic conditioners tested by Mme. MAHE, but to other species of cationic conditioners as well as other ingredients. This, however, does not defeat the clear and uncontraverted evidence of unexpected results presented in the Declaration.

While unexpected results must be “commensurate in scope with the claimed invention,” (M.P.E.P. § 716.02(d)), “commensurate in scope” does not mean “*identical* in scope.” Any other conclusion defies logic and common sense, as it would be impossible to test every single possible combination of elements that could be incorporated into a claim *comprising* various ingredients, as the Examiner appears to

suggest in the present Office Action. Rather, the M.P.E.P. provides a more logical course of action for determining the nonobviousness of claimed subject matter constituting a large genus, such as the present claims: “[t]he nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one skilled in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof.” *Id.* at § 716.02(d) I.

Indeed, the data for three species of cationic conditioners presented in Mme. MAHE’s September 13, 2005, Declaration establishes a clear trend that would allow one skilled in the art to extend the probative value to the entire genus of cationic conditioners claimed herein. And that trend, as admitted by the Examiner in the November 30, 2005, Office Action, indisputably establishes an “unexpected benefit.”

Moreover, the Office, after stating that Applicants must compare the claimed subject matter with the closest prior art, alleges that Applicants have failed to “compare[] the composition disclosed by Sweger et al. with the claimed invention.” Office Action at 6. Applicants respectfully disagree. While there is no evidence that Sweger is the “closest prior art,” Sweger nonetheless teaches compositions comprising a specific starch. *See Sweger, ibid.* Mme. MAHE’s Declaration evidences unexpected results of combining a starch as disclosed by Sweger with various cationic conditioners. Thus, the comparison is not only direct, but is sufficient to establish the unexpected results of the claimed composition.

Accordingly, reconsideration of the application and Mme. MAHE’s September 13, 2005, Rule 1.132 Declaration is respectfully requested.

B. Janchipraponvej in view of Sweger, Martino, and Uchiyama

Claims 1, 3, 18, 25, 28, 38, 39, and 43-58 have been further rejected as allegedly obvious over U.S. Patent No. 4,954,335 to Janchipraponvej ("Janchipraponvej") in view of Sweger, Uchiyama, and U.S. Patent No. 6,210,689 to Martino et al. ("Martino"). According to the Office, Janchipraponvej "teaches clear conditioning compositions" containing quaternary ammonium compounds. Office Action at 4. The Office admits that Janchipraponvej fails to teach "modified starch[es] and anionic surfactants," but attempts to rectify that deficiency with Sweger. *Id.* at 5. The Office further relies on Martino as teaching alkyl ether sulfate salts and Uchiyama as teaching a shampoo comprising an anionic surfactant. Applicants respectfully disagree and traverse this rejection.

As discussed above in Section III.A, Mme. MAHE's September 13, 2005, Rule 1.132 Declaration establishes unexpected results of combining the starch of Sweger with various cationic surfactants. Accordingly, the Office has not established the obviousness of the claimed invention, and the rejection should be withdrawn.

Moreover, as Applicants have discussed in detail on the record, the proposed combination of Janchipraponvej with Sweger would destroy the intended purpose of Janchipraponvej, which is to provide a clear composition. Indeed, incorporating the starch of Sweger into the composition of Janchipraponvej would destroy the composition's lauded clarity. See Applicants' November 10, 2004, Reply After Final; Applicants' May 24, 2004, Reply to Office Action; Applicants' December 1, 2003, Request for Reconsideration; and Mme. MAHE's November 24, 2003, Rule 1.132 Declaration. The destruction of the composition's clarity defeats an allegation of

obviousness since it is known that "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01 V.

Accordingly, Applicants respectfully request reconsideration of this ground for rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

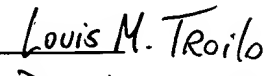
Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 21, 2006

By:


Erin C. DeCarlo
Reg. No. 51,688


Louis M. Troilo
Reg. No. 45,284

Ph.: 404-653-6464